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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,920	12/21/2005	Yoshitsugu Morita	71,051-002	2979
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EXAMINER				
KASSA, TIOABU				
ART UNIT		PAPER NUMBER		
1619				
MAIL DATE		DELIVERY MODE		
07/12/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/524,920

Applicant(s)

MORITA ET AL.

Examiner

TIGABU KASSA

Art Unit

1619

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 May 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3, 5, 6, 8-15, and 17.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Cherie M. Woodward/
Primary Examiner, Art Unit 1617

Continuation of 11: Applicants' proposed claim amendments do not place the case in condition for allowance or in better condition for appeal.

Applicants' amendment of claim 1 is taught in Kobayashi, as explained on page 5 of the Office Action mailed 3/11/2010 (see column 3, lines 24-28) and that the droplet amendments aren't limiting because oil inherently forms droplets or a separate layer in an aqueous solution as a physical interaction.

Response to arguments

Applicants' arguments filed 05/11/10 have been fully considered but they are not persuasive.

Applicants argue that the Examiner contends that the '660 patent discloses that its "suspension also contains non-cross-linked oil specifically being added in the silicone rubber particles . . ." (see page 5 of the Final Office Action). The Examiner goes on to state that this "addresses the limitation of the aqueous emulsions of cross-linked silicone particles as recited in instant claim 4." This is not correct because as clearly set forth in currently amended claim 1, component (A) has an average particle size of from 0.5 to 500 nm, and the particles of component (A) are dispersed in the droplets of component (D) in water.

The examiner respectfully disagrees with applicants' assertions because the distribution of the silicone particles within the composition is inherent since the distribution of components in the hydrophilic versus hydrophobic phases is based on the hydrophobicity/hydrophilicity of the components; therefore, the silicone particles are expected to be in the oil. Furthermore, it must be clear that the prior art should be considered as a whole. Kobayashi et al. indeed teach cross-linked silicone particles incorporated into non-crosslinkable oil. For example, Kobayashi et al. in column 7, practical example 1 teach a silicone rubber composition was prepared by uniformly mixing 96 parts by weight of a dimethylpolysiloxane closed by dimethylvinylsiloxy groups at both ends of the molecular chains, 4 parts by weight of a methylhydridopolysiloxane closed by trimethylsiloxy groups at both ends of the molecular chains, 6 parts by weight of a dimethylpolysiloxane closed by trimethylsiloxy groups at both ends of the molecular chains and an isopropyl alcohol solution of chloroplatinic acid (used in an amount which was such that the concentration of the platinum metal in this alcohol solution relative to the abovementioned dimethylpolysiloxane closed by dimethylvinylsiloxy groups at both ends of the molecular chains was 20 ppm). Next, the total amount of this silicone rubber composition was emulsified using 53 parts by weight of a 3 wt % aqueous solution of a polyoxyethylene nonylphenyl ether (HLB=13.1); afterward, 50 parts by weight of pure water was added, thus producing an aqueous emulsion of the abovementioned silicone rubber composition. The silicone rubber composition was cured by allowing the abovementioned aqueous emulsion to stand for 1 day at room temperature, thus producing an aqueous suspension of a powdered silicone rubber. This aqueous suspension was designated as cosmetic raw material (A). Kobayashi et al. then clearly teach for instance in column 11, practical example 7 that 14 parts by weight of cosmetic raw material (A), 2 parts by weight of 1,3-butylene glycol, 50 parts by weight of ethanol, 1 part by weight of a polyether-modified silicone oil (SH3771 manufactured by Toray-Dow Corning-Silicone K.K.), 4 parts by weight of propylene glycol, 1 part by weight of polyoxyethylene (15 mol adduct) nonyl ether, 1 part by weight of silicone-treated titanium oxide, an appropriate amount of a preservative, an appropriate amount of a fragrance and an appropriate amount of purified water were agitated for 10 minutes at 1500 rpm by means of a Henschel mixer, thus producing an aqueous cosmetic. The evaluation results obtained for this cosmetic are shown in Table 3. This exemplary teaching by itself demonstrates that the silicone rubber particles that are prepared as described above are added into a composition that contains 1 part by weight of a polyether-modified silicone oil (SH3771 manufactured by Toray-Dow Corning-Silicone K.K.). One of ordinary skill in the art would have inferred from this teaching s that silicone rubber particles that are prepared as described in the making of cosmetic raw material (A) is dispersed in a solution that contains 1 part by weight of a polyether-modified silicone oil (SH3771 manufactured by Toray-Dow Corning-Silicone K.K.) and other ingredients.

Applicants also argue that though no longer necessary in view of Applicants' amendment of independent claim 1, the Applicants once again assert the results obtained via the subject invention are unexpected, as set forth in Applicants' previous response. Interestingly, the Examiner contends that Applicants' data "is purely subjective and not substantiated with sound scientific data." (see, inter alia, page 11 of the Final Office Action). This conclusory statement by the Examiner has absolutely no support or basis in fact. The Examiner has failed to explain how an objective comparison of physical properties is "purely subjective," or how such an objective comparison "is not substantiated with sound scientific data." The Examiner is respectfully reminded that "[e]vidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut prima facie obviousness. Evidence that a compound is unexpectedly superior in one of a spectrum of common properties... can be enough to rebut a prima facie case of obviousness. No set number of examples of superiority is required." (emphasis added) MPEP § 716.02(a) (citing In re Chupp, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987)).

The examiner respectfully disagrees with applicants' assertions because evidence of unexpected results must be weighed against evidence supporting prima facie obviousness in making a final determination of the obviousness of the claimed invention. In re May, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978). Moreover, where the unexpected properties of a claimed invention are not shown to have a significance equal to or greater than the expected properties, the evidence of unexpected properties may not be sufficient to rebut the evidence of obviousness. In re Nolan, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977). The composition of Kobayashi et al. is expected to have the alleged properties absent of evidence to the contrary. Furthermore, the wetting capability of N-acyl taurates which applicants allege caused the unexpected properties is conventionally known as also demonstrated by Day stating that the N-acyl taurates made are useful as wetting agents, cleansing agents, and dispersants and may be used in a wide variety of products for detergent and personal care uses such as shampoos, lotions, bubble baths, and toilet soaps (column 1, lines 10-14 and column 4, lines 33-35). Given this available knowledge applicants' result is not unexpected absent of a strong data to the contrary. Additionally, the selection of a known material such as N-acyl taurates based on its suitability for its intended use supported a prima facie obviousness determination in Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945).

Applicants also argue that as expressly admitted by the Examiner, the '660 patent fails to disclose the instantly claimed surfactants, and merely states that a surfactant may be utilized. As such, Applicants' comparative data, which illustrates the superiority of Applicants' claimed surfactants relative to other common surfactants, in fact does compare the Applicants' claimed composition to the compositions of the '660 patent, contrary to the Examiner's assertion.

The examiner respectfully disagrees with applicants' assertions because the examiner could not find anywhere in the specification where applicant compared in parallel the composition of Kobayashi et al. The examiner requests applicants to point out which comparison that they are pointing to.

In addition, the Examiner contends that the compositions of the '660 patent include other ingredients in addition to the surfactants, so Applicants' comparative data is not representative of the compositions of the '660 patent. However, Applicants respectfully remind the Examiner that "Applicants may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the examiner." (emphasis added) MPEP § 716.02(e) (citing *In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978); *Ex parte Humber*, 217 USPQ 265 (Bd. App. 1961)). This may be true but when you have other variables and ingredients in the composition the effect of the alleged property due to the incorporation of N-acyl taurates should have been clearly demonstrated in a controlled fashion.

Applicants further argue that the fact that the compositions of the '660 patent may contain additional ingredients not included in the claimed composition is wholly irrelevant when the Applicants' comparative data is more closely related to the claimed invention than the compositions disclosed in the '660 patent, i.e., the Applicants' comparative data does not include the ingredients of the compositions of the '660 patent that are not utilized in the subject invention.

This is not found persuasive because applicants did not demonstrate and explain how the composition they used for comparison is substantially similar to the instant composition than the composition of Kobayashi et al. Kobayashi et al. clearly teach the instantly claimed invention except the use of N-acyl taurates, a limitation which is clearly rendered obvious by the teachings of Day.